



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 15

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

BS

~~Certificate~~

~~FEB 09 2005~~

COPY MAILED

FEB 04 2005

OFFICE OF PETITIONS

In re Application of Correction :
Seed et al. :
Application No. 09/939,537 : DECISION ON APPLICATION
Filed: August 24, 2001 : FOR PATENT TERM ADJUSTMENT
Atty Docket No. 00786/247003 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed December 22, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred forty-seven (347) days to three hundred seventy-two (372) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred seventy-two (372) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 31, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 347 days. The period of adjustment of 372 days for Office delay was reduced by 25 days for applicant delay. On December 22, 2003, applicants timely¹ submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 372 days. Applicants dispute the reduction of 25 days attributed to their delay in responding to the Notice to File Missing Parts of Application mailed October 31, 2001. Applicants state that a complete reply was received in the Office on January 16, 2002, and thus, there should have been no reduction for applicant delay on this basis. In support thereof, applicants submit a copy of their properly itemized and date-stamped postcard.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants are correct. Their response to the Notice to File Missing Parts of Application mailed October 31, 2001, is of

¹ PALM records indicate that the Issue Fee was also received in the Office on December 22, 2003.

record in the application with a date of receipt by the Office of January 16, 2002. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 25 days. The response was filed within the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred seventy-two (372) days.

Applicants submitted \$400 for the fee set forth in 37 CFR 1.18(f). However, the appropriate fee for consideration of this application for patent term adjustment pursuant to § 1.705(b) is the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required. The overpayment of \$200 has been refunded to Deposit Account No. 03-2095, as authorized.

It is noted that on July 14, 2004, the Office mailed a NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(b)(3) in the instant application. Pursuant to that Notice, the application file is being returned to Technology Center 1600 for appropriate action.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen